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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/463,098 05/15/00 NICOSIA

A MEWBURN

000110 HM12/0604
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1601 MARKET STREET
PHILADELPHIA PA 19103-2307

EXAMINER

WESSENDORF, T

ART UNIT

PAPER NUMBER

1627

DATE MAILED:

06/04/01

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/463,098

Applicant(s)
Nicosla et al

Examiner
T. Wessendorf

Art Unit
1627



– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 3/29/01

2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-14, 17, 19-58, 60-62, 64-68, 70-78, 81-86, and 88-96 is/are pending in the applica

4a) Of the above, claim(s) _____ is/are withdrawn from considera

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims 1-14, 17, 19-58, 60-62, 64-68, 70-78, 81-86, and 88-96 are subject to restriction and/or election requirem

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other:

Art Unit: 1627

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CAR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-14, 17,19-31, drawn to library and method of use for screening epitope of HVR1 of HCV strain.

Group II, claim(s) 32-57, drawn to a mixture of peptides obtained from a library .

Group III, claim(s) 58, 60-62, 64-67, drawn to nucleic acid, host cell, method for producing a peptide.

Group IV, claim(s)68, 70-78, 81-83, drawn to a method of obtaining an antibody molecule.

Group V, claim(s)84-86, 88-96, drawn to antibody molecule and obtaining antibodies.

The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the library and method of Group I lack the corresponding special technical feature of Group II which is the final product i.e., a mixture of

Art Unit: 1627

peptide obtained from screening a library. Group I, library of antigens which contains amino acids does not have the special technical feature of a nucleic acid and antibody of Group V since each is of different structures and functions. Furthermore, Group I method of screening lack the corresponding special technical feature of the method of Group IV for obtaining an antibody molecule.

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Under Group I:

- A). Library of Formula I or Formula III.
- B). Nucleic acid expression of peptide or non-nucleic acid synthesis of the peptide (e.g., claim 11).
- C). Recombinant process or peptide synthesis (e.g., claim 17).
- D). Compound per se or composition (e.g., claim 19) or fusion protein per se (claim 22) or in composition form (e.g., claim 24).

Under Group II:

- A). Formula II or in composition form
- B). Fusion composition
- C). Pharmaceutical composition

Art Unit: 1627

Under Group III:

- A). Peptide species
- B). Peptide composition

Under Group IV:

- A). Peptide
- B). Fusion Protein
- C). Ab from nucleic acid expression or non-nucleic acid synthesis

Under Group V:

- A). Single peptide
- B) Composition

Applicant is required, in reply to this action, to elect a single species from whichever group is elected to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CAR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

Art Unit: 1627

Applicants should group or identify the claims that read on the elected species.

The following claim(s) are generic: 1, 32, 58, 68, 84.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: the species of subgroup A of formula I lack the special technical features of species of formula III. Likewise the nucleic acid expression lack the special technical features of peptide synthesis which employs either solid phase or solution phase synthesis i.e., non-biological nucleic acid process. Also, the compound species of subgroup D lack the special technical features of a fusion protein or composition which contains additional component as in fusion or simply in admixture with an excipient as in a composition form.

The same reasons apply to the other Groups that contain the particular species as set forth above.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CAR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CAR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CAR 1.48(b) and by the fee required under 37 CAR 1.17(I).

Art Unit: 1627

Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

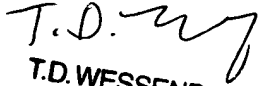
Certain papers related to this application may be submitted to Art Unit 1627 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 O.G. 61 (November 16, 1993) and 1157 O.G. 94 (December 28, 1993) (see 37 C.F.R. 1.6(d)). The official fax telephone numbers of the Group are (703)308-7924. NOTE: If applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. Wessendorf whose telephone number is (703) 308-3967. Any

Art Unit: 1627

inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

tdw
6/1/01


T.D. WESSENDORF
PRIMARY EXAMINER